UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,504	12/27/2000	Guido Maffezzoni	ADAPP141	9483

25920	7590	06/15/2005

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EXAMINER
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ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/752,504	MAFFEZZONI, GUIDO
	Examiner	Art Unit
	Tadesse Hailu	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 March 2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23,35 and 36* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-23, 35-36* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the AMENDMENT submitted/entered with

filling of RCE on March 24, 2005.

2.   The pending claims 1-23, and 35-36 are examined herein as follows:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1, 12 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing

to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The Examiner could not locate the claimed

subject matter, "*the configuration changes being saved without being activated;*" (of

claim 1), similarly *"the changes to the configuration being saved without being activated"*

(of claim 12) and *"the writing being performed without activating the user selection"* (of

claim 20) in the specification, as indicated by the Applicant, that is, on page 7, lines 17-

23 and page 21, lines 5-7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-3, 8-10, and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Symbios Inc., PCI SCSI Device Management system SDMS 4.0, User's Guide Version 7.0, 1998.

Symbios discloses PCI SCSI Device Management System. Specifically, the claimed subject matter of the current application is described and illustrated in chapter 5 (Device Drivers for Windows NT 3.5x/4.x).

With regard to claim 1:

As per "A method for managing a configuration of a host adapter for a computer, the host adapter allowing communication between the computer and a peripheral device connected to the host adapter," (see pages 1-2, and 21).

As per "generating a graphical user interface, the graphical user interface being configured to allow a user to access configuration settings of the host adapter;" (see page 28).

As per "managing the configuration settings of the host adapter by way of the graphical user interface to create configuration changes, the configuration changes being saved to a file in a storage location," (see pages 28-29 and 32). The claim further recites "the configuration changes being saved without being activated;" Symbios teaches rebooting (see page 34) the computer for configuration change to take effect. But the Examiner could not locate this teaching on the Specification of the application as indicated by Applicant on pages. (i.e., page 7, lines 17-23 and page 21, lines 5-7).

As per "rebooting the computer, the rebooting using code having program,
instructions for locating the file having the saved configuration changes;" (page 34).

As per "reading the configuration changes saved to the file in the storage
location, the reading being performed during the rebooting of the computer;" (pages 26).

As per "writing the configuration changes to a nonvolatile memory of the host
adapter of the computer, the writing being performed during the rebooting of the
computer;" (pages 26, 27 and 34).

As per "activating the configuration changes for the host adapter during the
rebooting of the computer so that the computer uses the configuration changes when
communicating with the host adapter" (pages 28-29 and 32).

As per "wherein the graphical user interface provides the user with a look and
feel of system components visible and accessible through the operating system of the
computer." (see pages 1-2, and 6, and 24). Furthermore, since Symbois implements
the utility program under Windows NT (i.e., graphical user interface environment), the
user will visualize the configurable system components and access each component
through the NT operating system (pages 24, 25 and 32).

With regard to claim 2:

As per "... informing the user that the setting changes will not be available until
the rebooting of the computer is complete." (page 34).

As per "prompting the user to execute a reboot command." (pages 24 and 34).

With regard to claim 3:

As per "...wherein the managing the configuration of the host adapter includes:

determining what peripheral devices are connected to the host adapter." (pages 32-33).

With regard to claim 8:

As per "... wherein the host adapter is a SCSI host adapter." (pages 28-29).

With regard to claim 9:

As per "... wherein a system BIOS of the computer reads the configuration

changes saved to the file in the storage location." (pages 29-30).

With regard to claim 10:

As per "... wherein the storage location is defined in storage associated with one

of a hard drive of the computer and a memory chip." (page 32).

With regard to claim 12:

As per "A method for accessing and managing a configuration of a host adapter

for a computer, the host adapter providing communication between the computer and a

peripheral device connected to the computer," (see pages 1-2, and 21).

As per "generating a graphical user interface;" (pages 24, 26 and 32).

As per "accessing and managing the configuration of the host adapter by way of

the graphical user interface, the accessing and managing of the configuration including

making changes to the configuration;" (pages 24, 26 and 32).

As per "saving the changes to the configuration to a registry key," (pages 13-15,

35 and 38). The claim further recites "the changes of configuration being saved without

being activated;" Symbios teaches rebooting (see page 34) the computer for

configuration changes to take effect. But the Examiner could not locate this teaching on

the Specification of the application as indicated by Applicant on pages. (i.e., page 7,

lines 17-23 and page 21, lines 5-7).

As per "receiving a command to reboot the computer;" (page 34).

As per "executing the command to reboot the computer and initiating a reboot

operation;" (pages 27 and 34).

As per "reading the changes to the configuration saved to the registry key during

the reboot operation;" (pages 13-15, 28-29, and 32).

As per "writing the changes to the configuration to a nonvolatile memory of the

host adapter of the computer during the reboot operation;" (pages 26, 27 and 34)

As per "wherein the graphical user interface provides the user with a look and

feel of system components visible and accessible through the operating system." (see

pages 1-2, and 6, and 24). Furthermore, since Symbois implements the utility program

under Windows NT (i.e., graphical user interface environment), the user will visualize

the configurable system components and access each component through the NT

operating system (pages 24, 25 and 32).

With regard to claim 13:

As per "... wherein the initiating of the reboot operation includes shutting down all

applications and all system devices." (pages 24, and 34).

With regard to claim 14:

As per "... wherein the reading of the changes to the configuration saved to the

registry key is by a device driver at Ring 0 after the shutting down of all applications."

(pages 24, and 34).

With regard to claim 15:

As per "... wherein the writing of the configuration changes to the nonvolatile memory of the host adapter of the computer is by the device driver at Ring 0 after the reading of the changes to the configuration saved to the registry key." (pages 15-17, 31-32, and 24-28).

With regard to claim 16:

As per "... wherein the reboot operation includes shutting down of an operating system after the writing of the configuration changes to the nonvolatile memory of the host adapter and then an executing of a boot sequence by a system BIOS." (pages 15-17, 31-32, and 24-28).

With regard to claim 17:

As per "... reading the configuration of the host adapter with the configuration changes by the system BIOS during the boot sequence;" (pages 15-17, 31-32 and 24-28).

As per "initializing the computer and the host adapter in accordance with the configuration of the host adapter with the configuration changes." (pages 15-17, 31-32 and 24-28).

With regard to claim 18:

As per "... , wherein the host adapter is a SCSI host adapter." (page 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 4-7, 19, 35 and 36 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Symbios Inc., PCI SCSI Device Management system SDMS 4.0,

User's Guide Version 7.0 in view of Sun™ StorEdge ™ A5000 Installation Guide, for

Windows NT Server 4.0

Symbios describes menu or selectable lists of representation of host adapters in

a GUI, but Symbios does not illustrate or describe an icon representation of a host

adapter (a host adapter icon) as specified in **claim 4**. Also, while Symbios discloses

providing access to the host adapter and peripheral devices attached to the host

adapter (pages 26-34), but Symbios doe not expressly illustrate or describe selecting

the host adapter icon, wherein selecting the host adapter icon being configured to

provide access to the host adapter and peripheral devices connected to the host

adapter as specified in **claim 5**. Furthermore, while Symbios describes list or menu for

accessing the diagnostic tools for managing the configuration of the host adapter

(pages 26-34), but, again, Symbios does not expressly describe a host adapter icon to

provide access to diagnostic tools as specified in **claim 7**. Furthermore, Symbios

describes "informing the user that the configuration changes will not be available until

the reboot operation is complete;" (pages 24 and 34) and "prompting the user to select

the command to reboot the computer" (pages 24 and 34); in addition, while Symbios

describes generating a menu or selectable list in the graphical user interface (page 28)

to provide a user access to the host adapter and any device attached to the adapter, but

Symbios does not illustrate or describe the host adapter icon as specified in **claim 19.**

As shown in Symbios, NTCONFIG Utility is a menu driven utility including menu

bars, scroll bar manipulated with mouse cursor (chapter 5, pages 32-33). Symbios also

discloses device selection menu (chapter 5, page 32), wherein the devices are

represented as selectable lists, not icons as claimed in claims 4-7, and 19. However,

Sun™ StorEdge ™ A5000 Installation Guide, for Windows NT Server 4.0 (Sun)

discloses these shortcomings. Sun discloses, among other things, an icon

representation of devices (SCSI host adapters) (see Sun pages 4-9), Therefore, it would

have been obvious to one having ordinary skill in the art at the time of the invention was

made to use iconic representation in place of list or textual representation because user

will perform better by using iconic interaction than textual or selectable list interface.

Symbios in view of Sun further discloses that the selecting of the host adapter

icon provides access to the configuration settings of the host adapter as specified in

claim 6 (Symbios, pages 26-34).

Symbios in view of Sun further discloses access to any device connected to the

host adapter includes providing for configuration and management of any device

connected to the host adapter as specified in claims **35 and 36** (Symbios, pages 26-34).

6.   Claims 11, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Symbios Inc., PCI SCSI Device Management system SDMS 4.0, User's Guide

Version 7.0 in view of Admitted Prior Art.

With regard to claim 20:

As per "displaying a graphical user interface, the graphical user interface providing a list of selectable configuration options;" (pages 26-28).

As per "receiving user selections of change options provided by the list of selectable configuration options;" (pages 26-29).

As per "writing the user selections to a storage location," (pages 26). The claim further includes "the writing being performed without activating the user selection;" Symbois teaching rebooting the computer for a change , such as writing to take effect(pages 24, 26 and 34).

As per "initiating a reboot of the computer, the rebooting using code having program instructions for locating the storage location to read the user selections;" (pages 24 and 34).

As per "completing the rebooting, the SCSI host adapter being configured to operate in accordance with the user selections;" (pages 24 and 34).

As per "wherein the graphical user interface provides the user with a look and feel of system components visible and accessible through the operating system of the computer." (see pages 1-2, and 6, and 24). Furthermore, since Symbois implements the utility program under Windows NT (i.e., graphical user interface environment), the user will visualize the configurable system components and access each component through the NT operating system (pages 24, 25 and 32).

Symbois discloses most of the claimed subject matter except for the association of EEPROM with a SCSI host adapter, that is, "writing the user selections from the

storage location to the EEPROM. Symbois instead describes NVRAM associated with

SCSI host adapter (pages 26 –28). However, the Admitted prior art describes the

association between the EEPROM and SCSI, SCSI host adapters contain EEROM as

claimed in the above limitations (Application, page 3 lines 3-14).

The Admitted Prior Art and Symbois are analogous art because they are from the

same field of endeavor, managing device setting.

At the time of the invention, it would have been obvious to a person of ordinary

skill in the art to replace NVRAM (non-volatile random access), the type of memory

used in Symbois with EEPROM (also non-volatile memory, electrically erasable

programmable read only memory) of the Admitted prior art. The suggestion /motivation

for doing so would have been an obvious functional equivalent. Since both are non-

volatile memories that store instructions or configuration settings for the SCSI host

adapter, they would perform equally well.

Therefore, it would have been obvious to combine the Admitted Prior Art with

Symbios to obtain the invention as specified in claims 20.

With regard to claim 21:

Symbios in view of Admitted Prior Art discloses that the graphical user interface

includes selections to initiate diagnostic testing of the SCSI host adapter." (Symbios,

pages 18-22, 38).

With regard to claim 22:

Symbios in view of Admitted Prior Art discloses that the storage location is

defined in storage associated with one of a hard drive of the computer and a memory

chip." (Symbios, pages 26-32).

With regard to claim 11:

Symbios in view of Admitted Prior Art discloses that the system BIOS writes the

configuration changes to an EEPROM of the host adapter." (The Admitted Prior Art,

page 3, lines 3-14).

7.   Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Symbios

in view of Sun as applied to claims 4-7, 19 and 20 above, and further in view of The

Admitted Prior Art.

Again Symbios discloses a graphical user interface is displayed following a

selection of a SCSI host adapter list or menu (pages 27 and 32), but Symbios does not

illustrate or describe the host adapter icon as specified in claim 23. However, as

applied to claims 4-7 and 19 above, Symbios in view of Sun describes such host

adapter icon (see Sun pages 4-9). Furthermore, Symbios in view of Sun, however, does

not show the association of EEPROM with the host adapter as claimed in claim 23, but

as given rejection to claim 20, such limitation is describes in the Symbios in view of

Admitted Prior Art (Admitted Prior Art, page 3, lines 3-14).

Response to Arguments

8.   Applicant's arguments filed 6/28/2004 have been fully considered but they are

not persuasive. Applicant argues that Symbois utility configuration program does not

provide the look and feel of visibility and accessibility through the operating system. The

Examiner disagrees because "the look and feel of visibility" is nothing more than running

a configuration program within a graphical user interface operating system environment

rather than text based environment, thus, Symbois utility configuration program runs

within Windows NT environment, where one can visualize (i.e., graphically) the

operation environment.

Regarding the registry key argument, where the Applicant states that Symbios

teaches away from a registry key, the Examiner disagrees because as indicated above

in claim 12 rejection, Symbois describes a registry key (pages 13-15, 28-29, and 32).

And regarding EEPROM argument, the Applicant Symbios does not disclose

flashing the configuration changes to an EEPROM and writing the user selections from

the storage location to the EEPROM. In contrast to the Applicant's, although Symbios

discloses NVRAM (non-volatile memory) instead EEPROM (also non-volatile memory),

the Admitted Prior art teaches EEPROM in association with the claimed subject matter

(Application, page 3, lines 3-14).

CONCLUSION

9.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-

4051. The Examiner can normally be reached on M-F from 10:30-7:00 ET. If attempts to

reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John

Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

10.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

Patent examiner
Tadesse Hailu
Art unit 2173
6/8/05